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OGILVY RENAULT LLP
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL, QC H3A2Y3
CANADA

EXAMINER
THAI, HANH B

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/987,828
Filing Date: November 16, 2001
Appellant(s): MCDONALD ET AL.

Kent Daniels P. Eng.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 20, 2008 appealing from the Office action mailed May 30, 2007.

Remarks

The examiner noted incorrect patent number was correlated with Dietrich. Specifically Dietrich should have been identified as patent number 6,055,442, and not 6,879,989. Irrespective of the typo, applicant's content of argument consistently referrenced the correct Dietrich number 6.055,442. In view of this consistency, and for prosecution efficiency, the examiner has decided to proceed responding to the brief filed March 20, 2008, with the present Examiner's answer.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,968,209   AHLGREN   11-2005

6,055,442   DIETRICH   4-2000

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 2-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ahlgren et al. (US 6,968,209 B1) new cited in view of Dietrich et al. (US 6,055,442).

Regarding claim 6, Ahlgren discloses a method applied by an electronic token

comprising a microprocessor and a memory for identifying changed records among a plurality of

records stored in a memory of the electronic token, the method comprising:

- calculating in the memory a change detection code (CDC) associated with the record

  (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses calculating

checksum stored in the SIM card reads on the claimed "calculating in the memory a

change detection code");

- comparing in the electronic token the calculated CDC with a corresponding stored

  CDC associated with the record in order to determine if the record has changed since

  the stored CDC was calculated (abstract; summary; col. 4, lines 24-34 and lines 58-

  65, Ahlgren) and

- if the calculated CDC of at least one of the plurality of records is not equal to the

  stored CDC, and saving the calculated CDC of the record as the stored CDC of the

  record (abstract; summary and col. 4, lines 35-54, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token

and sending the message to a registering element. Dietrich discloses short message

service for a mobile radio network including generating a short message service and

sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10,

Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to provide a short message service of Dietrich into the Ahlgren's

system to derive the invention as claimed. The motivation of doing so would have been to

provide efficient and reliable use of the short message in updating records of the mobile

device (col.1, lines 60-63, Dietrich).

Regarding claim 2, Ahlgren/Dietrich combination further discloses a step of calculating a

cyclic redundancy check (col.4, lines 10-22, Ahlgren).

Regarding claim 3, Ahlgren/Dietrich combination further discloses a step of determining

if the at least one associated record is changed and yields information regarding the change, the

information being input to the predefined algorithm (summary; col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 4, Ahlgren/Dietrich combination further discloses the step of issuing a message to an electronic token reader in which the electronic token is docked, the message containing at least one parameter regarding the change for use by a registering element to which the message is sent by a token-resident applet via the electronic token reader (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 5, Ahlgren/Dietrich combination disclose a step of setting a response pending flag which is cleared if an acknowledgement of the message is received, wherein the flag is used to indicate that a message was not acknowledged (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 7, Ahlgren/Dietrich combination disclose a step of using any flag set in association with the stored CDC, in conjunction with the values of the stored CDC and calculated CDC to determine if the record was changed since a last acknowledged message related to the record was sent (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 8, Ahlgren/Dietrich combination disclose a step of sending the message to the registering element, which performs at least one of: synchronization of data across multiple data stores; update of a system with respect to the record; back-up of the record; and provision of a service feature in dependence on the change to the record (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 9, Ahlgren/Dietrich combination discloses steps of issuing a short message service message to a service provider that has access to the registering element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 10, Ahlgren/Dietrich combination disclose steps of: receiving information relating to the change; formulating a notice of change (NOC) message; and inserting as many NOC messages as possible into the SMS message before sending the SMS message (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 11, Ahlgren/Dietrich combination disclose that the electronic token is a subscriber identity module and the step of comparing further comprises a step of applying a comparison algorithm that executes on the subscriber identity module, the comparison algorithm being adapted to compare a CDC of each of a plurality of abbreviated dialing numbers in the file; and the step of issuing comprises a step of directing a SMS message to the registering element, which is adapted to perform at least one of the following: ensure conformity of the file with other versions of the file stored elsewhere; back-up the file; and, provide a service feature in dependence on the change (col.3, lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 12, Ahlgren/Dietrich combination disclose steps of formulating the message by inserting the at least one parameter into respective fields of the message, and forwarding the message to the registration element (summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claim 13, Ahlgren/Dietrich combination discloses steps of inserting a record identifier, and information that specifies the change (col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 14, Ahlgren/Dietrich combination discloses a step of inserting a value that indicates one of the following: the record was added; the record was deleted; and the record was modified (col.3, lines 11-21; col. 4, lines 24-65, Ahlgren).

Regarding claim 15, Ahlgren discloses an apparatus for providing a service to a subscriber having an electronic token, the apparatus comprising:

a change detection applet stored on the electronic token including a microprocessor and a memory, the electronic token storing a plurality of records and a set of change detection codes (CDCs), each CDC being associated with a respective stored record and identifying a version of the stored record (abstract; col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum stored in the SIM card reads on the claimed "electronic token storing a set of records and change detection codes"), said applet being adapted to be executed by the microprocessor of the electronic taken and adapted to identify any record that has been changed since a change detection code (CDC) for the record was stored in the card (summary; col. 4, lines 24-34 and lines 58-65, Ahlgren) by calculating a current CDC for the record and comparing such current CDC with the stored CDC (summary; col. 4, lines 24-65, Ahlgren).

Ahlgren, however, does not disclose preparing a SMS message in the electronic token and sending the message to a registering element. Dietrich discloses short message service for a mobile radio network including generating a short message service and sending the message to the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to provide a short message service of Dietrich into the Ahlgren's

system to derive the invention as claimed. The motivation of doing so would have been to

provide efficient and reliable use of the short message in updating records of the mobile

device (col.1, lines 60-63, Dietrich).

Regarding claim 16, Ahlgren/Dietrich combination discloses the change detection applet

calculates a cyclic redundancy check (CRC) to derive the current CDC (col.4, lines 10-22,

Ahlgren).

Regarding claim 17, Ahlgren/Dietrich combination discloses back up records for which

the NOC message was generated; synchronize the file with other files remotely stored but

commonly associated with a subscriber; and, provide a service dependent upon the detected

change (col.4, lines 10-65, Ahlgren).

Regarding claim 18, Ahlgren/Dietrich combination discloses the electronic token is

docked in a communications enabled device that comprises an electronic token reader adapted to

exchange data in conformity with a predetermined protocol (col.3, lines 11-21; col. 4, lines 24-34

and lines 58-65, Ahlgren).

Regarding claim 19, Ahlgren/Dietrich combination discloses a subscriber identity module

(SIM) card compliant with a global system for mobile communications (GSM) standard; and a

universal SIM (USIM) card (see Fig.1-3 and corresponding text, Ahlgren).

Regarding claim 20, Ahlgren/Dietrich combination discloses the communications

enabled device is adapted to function as a short message service (SMS) enabled telephone (col.3,

lines 11-21; col. 4, lines 24-34 and lines 58-65, Ahlgren).

Regarding claim 21, Ahlgren/Dietrich combination discloses a data store for storing a set
of response pending flags that are associated with a list of records in the file, and the change
detection applet is further adapted to use the set of response pending flags to determine if a
record may have been changed since a last NOC message for the record was acknowledged
(col.4, lines 46-53 and line 66 to col.5, line 6, Ahlgren).

Regarding claim 22, Ahlgren/Dietrich combination discloses the set of response pending
flags comprises at least two flags used to encode change information, and the change detection
applet is further adapted to use the plurality of flags, in conjunction with the stored CRC and
current CRC, to determine if a notice of change message related to the record is to be sent
(summary; col. 2, line 48 to col. 3, line 10, Dietrich).

Regarding claims 24-25, Ahlgren discloses a change applet stored on an electronic token
including a microprocessor and a memory, the electronic token storing a plurality of records and
a set of change detection codes (CDCs), each CDC being associated with a respective stored
record and identifying a version of the stored record, said applet being adapted to be executed by
the microprocessor of the electronic token and adapted to identify any record that has been
changed since a change detection code (CDC) of the record was stored in the card (abstract;
col.2, lines 59-62 and col. 4, lines 9-22, Ahlgren discloses log file of records and a checksum
stored in the SIM card reads on the claimed "electronic token storing a set of records and change
detection codes"), by calculating a current CDC for the record and comparing such current CDC
with the stored CDC (col.2, lines 59-62 and col. 4, lines 9-65 Ahlgren discloses calculating
checksum stored in the SIM card and comparing the checksum reads on the claimed "calculating
a current CDC" and "comparing current CDC with the stored CDC").

Ahlgren, however, does not disclose preparing a SMS message in the electronic token

and sending the message to a registering element. Dietrich discloses short message service for a

mobile radio network including generating a short message service and sending the message to

the subscriber (see summary; col. 2, line 48 to col. 3, line 10, Dietrich). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to provide a short

message service of Dietrich into the Ahlgren's system to derive the invention as claimed. The

motivation of doing so would have been to provide efficient and reliable use of the short message

in updating records of the mobile device (col.1, lines 60-63, Dietrich).

(10) Response to Argument

Applicant arguments (response 3/20/08, pages 5-7) suggesting any impropriety in the

final rejection and requesting withdrawing the finality of the office action have been thoroughly

considered. However requesting withdrawal of finality of an office action is a petitionable

matter, not appealable matter. As such the arguments are moot in this appeal.

Applicant argues, "Ahlgren et al. fails to teach or fairly suggest that a checksum is

calculated in the electronic token as required by the claims" (response 3/20/08, pages 7-8). This

argument is **not** persuasive simply because none of the claims supports the point being argued..

Examiner respectfully points out that the claim (claim 6) fails to specify "multiple checksums"

calculation's task.

Applicant's arguments regarding calculating a respective change detection codes (CDCs) associated with each record of a plurality of records stored in the memory of a token (response 3/20/08, page 8) have been considered but have not found persuasive.

Ahlgren clearly discloses calculating in the electronic token a change detection code (CDC) for each record in the memory (col.2, lines 57-64, Ahlgren) and comparing the calculated CDC with a stored CDC (col.2, lines 64-67, Ahlgren) in the manner similar to the claimed language.

Applicant argues, "Ahlgren does not teach the sequence of steps. Rather Ahlgren explicitly teaches that a checksum is calculated _after_ the comparison." (response 3/20/08, pages 8-9). This argument is not true, because calculation must be done before any value could be compared.

Applicant argues, "Ahlgren provides no motivation for modifying the process …offers no prospect that such a modification would even be usable."

The argument alleging lack of motivation to combine has been found persuasive. On contrary, page 4, 1st paragraph of the office action clearly set forth the motivation would be to enable efficient/reliable short messaging.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Hanh Thai

May 29, 2008

Conferees:

Hanh Thai

Patent Examiner, AU 2163

Don Wong

Supervisory Patent Examiner, AU 2163

/don wong/

Supervisory Patent Examiner, Art Unit 2163

/John Breene/

Supervisory Patent Examiner, Art Unit 2162